

Serial No.: 09/741,406

Attorney's Docket No.: 10559/295001/P9306

REMARKS

In view of the foregoing amendments and the following remarks, reconsideration and allowance are respectfully requested.

Claims 1-3, 5-12, 14-26 and 28 are currently pending, with Claims 1, 10 and 19 being independent claims.

Claims 1-3, 5-12, 14-26 and 28 stand rejected under 35 U.S.C. 102(e) as allegedly being anticipated by Gilbrech et al. This contention is respectfully traversed.

Claim 1

The amended Claim 1 is patentable over Gilbrech at least because Gilbrech fails to anticipate each and every feature as stated in Claim 1. For a claim to be anticipated by the prior art, it is necessary that a single prior art reference disclose each element of the claim under consideration. *Minnesota Mining and Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992).

Claim 1 is patentable over Gilbrech because Gilbrech fails to anticipate a server as disclosed in Claim 1. The Office Action acknowledges that the term "server" is not disclosed. When a U.S. patent is used to reject claims under 35 U.S.C. 102(e), the disclosure relied on in the rejection must be

Serial No.: 09/741,406

Attorney's Docket No.: 10559/295001/P9306

present in the issued patent (MPEP 2136). The Office Action asserts that a VPNU as disclosed in Gilbrech performs the same functions of a server component as in Claim 1. The Applicants respectfully argue that the VPNUs disclosed in Gilbrech do not perform the same functions for several reasons.

The Gilbrech patent cannot anticipate Claim 1 because the disclosure in Gilbrech does not disclose the same functionality as Claim 1 and will not work on real "private network" environments, such as a home private network. No new matter has been added. See page 2, lines 4-14 of the disclosure for support. Even if one or more elements (e.g., the server) of the claims are not expressly disclosed in a prior art reference, the reference may still anticipate the invention if it necessarily or inherently functions in accordance with, or includes, the claimed limitations. *Atlas Powder Co. v. IRESCO Inc.*, 190 F.3d 1342, 1347 (Fed. Cir. 1999). However, Gilbrech cannot necessarily or inherently function in accordance with all of the claimed limitations of Claim 1, and cannot anticipate Claim 1. The Gilbrech disclosure requires a VPNU on both sides, i.e., a VPNU at the remote client as well as receiving end. Gilbrech discloses that the VPNU should be in the path of data traffic, and can reside between a site's router and the path to the Internet (Gilbrech: Fig. 2; Col. 6, lines 36-45). Gilbrech discloses that the VPNUs should be bi-directional (i.e., VPNUs

Serial No.: 09/741,406

Attorney's Docket No.: 10559/295001/P9306

connect to each other) (Gilbrech: Fig. 2; Col. 6, lines 36-45). In contrast, Claim 1 does not require a VPN-type agent residing at the remote client side, and the VPN-type agent cannot have the same functionality as in Claim 1.

The server and agent components recited in Claim 1 can be used with the public/unsecured Internet, meaning that both the communication from client-to-server and server-to-home go through the public/unsecured Internet. Gilbrech can only secure communication between VPNU's. Thus, if one VPNU is assigned as remote client and the other as server, then the communication between the server and the home would not be secured. Therefore, the only approach to use Gilbrech as alleged would be to put one VPNU at home and the other VPNU in the remote client (and have no server). However, such an attempt would make it extremely difficult for the remote client VPNU to establish the connection directly.

Claim 1 is patentable at least because Gilbrech fails to disclose each and every feature of the claims. The VPNUs in Gilbrech have fixed (static) IP addresses or a mechanism to connect to other VPNUs. Gilbrech discloses that the IP data packet includes a destination address (IP Address) of the receiving VPNU (Gilbrech: Col. 8, line 34). However, Claim 1 recites a dynamically-assigned address for the agent component and a persistent address for the server. Essentially, one

Serial No.: 09/741,406

Attorney's Docket No.: 10559/295001/P9306

skilled in that art would know that in the environment for the home-to-remote client and remote client-to-home connections, an outwardbound connection is easy to establish from the home to the Internet to the remote client, but establishing a connection in the opposite direction (from remote client to home) poses difficulties. The reason for such a constraint in the opposite direction is that an ISP assigns a dynamic IP address to the home contact point device (e.g., a Residential Gateway) (Disclosure: page 2, lines 4-14). Without a persistent address, remote clients have difficulty locating, and therefore, accessing the home contact point. In Claim 1, the agent establishes a persistent connection with the server and the agent can have a dynamically-assigned address. The connection between the agent and the server is persistent. When a remote client wants to access the private network, the remote client doesn't have to connect to the agent directly. The remote client connects with the server, which has a permanent address and already has an established connection with the agent component. The agent component has a connection to the private network (or may be implemented within the private network as in Claim 28).

Gilbrech would have difficulty using a dynamic IP address from the ISP. For example, if Gilbrech was attempted to be used under such an dynamic environment, the VPNU would have to be the

Serial No.: 09/741,406

Attorney's Docket No.:10559/295001/P9306

home contact point and the VPNU would get the dynamic IP address from the ISP, making it extremely difficult to a remote client VPNU to establish the connection directly. However, Claim 1 does not suffer such a limitation.

For at least these reasons, the Applicants respectfully submit that Claim 1 is patentable over the cited reference, and the 35 U.S.C. 102 rejection should be withdrawn.

Claims 10 and 19

Independent Claims 10 and 19 are patentable for at least the same reasons as Claim 1. Allowance of Claims 10 and 19 is respectfully requested.

Claims 2-3, 5-9, 11-12, 14-18, 20-26 and 28

Claims 2-3, 5-9, 11-12, 14-18, 20-26 and 28 are all patentable at least for depending on an allowable base claim (base Claim 1 for Claims 2-3, 5-9; base Claim 10 for Claims 11-12, 14-18; base Claim 19 for Claims 20-26 and 28). These dependent claims are also patentable for reciting patentable subject matter in their own right.

For example, Claim 28 relies on Claim 19 and provides advantages over Gilbrech in that the system of Claim 19 recites a system allowing an easy-to-establish outbound connection from the home to the Internet and an easy-to-establish inbound

Serial No.: 09/741,406

Attorney's Docket No.:10559/295001/P9306

connection from the Internet to the home. Claim 19 has features similar to Claim 1. Claim 1, recites "a method to enable a device at a public network to establish a connection into a private network" by establishing "a persistent connection from an agent component to a server" and creating with the agent component, "a connection between the private network and the device via the first server". So when a remote client wants to access the home, the remote client does not need to connect to the home agent directly, but instead goes to the Server component, which had already established a connection from the home agent. Also, for the reasons described above, the VPN as disclosed in Gilbrech cannot be implemented inside of the private network.

For at least these reasons, the Applicants respectfully request that dependent Claims 2-3, 5-9, 11-12, 14-18, 20-26 and 28 be placed in condition for allowance.

Serial No.: 09/741,406

Attorney's Docket No.: 10559/295001/P9306

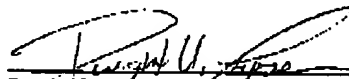
Conclusion

In view of the amendments and remarks herein, the Applicants believe that Claims 1-3, 5-12, 14-26, and 28 are in condition for allowance and ask that these pending claims be allowed. The foregoing comments made with respect to the positions taken by the Examiner are not to be construed as acquiescence with other positions of the Examiner that have not been explicitly contested. Accordingly, Applicants' arguments for patentability of a claim should not be construed as implying that there are not other valid reasons for patentability of that claim or other claims.

No fees are believed to be due at this time. Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: 03/23/05

  
Dwight U. Thompson  
Reg. No. 53,688  
Agent for Intel Corporation

Fish & Richardson P.C.  
PTO Customer Number: 20985  
12390 El Camino Real  
San Diego, CA 92130  
Telephone: (858) 678-5070  
Facsimile: (858) 678-5099  
10482937.doc